

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

161

3736

Applicant: ALFERNESS ET AL.
Serial No.: 09/880,576
Filed: JUNE 13, 2001
Confirmation No.: 7153

Examiner: B. SZMAL
Group Art Unit: 3736
Docket: 11998.5USC2
Notice of Allow. N/A
Date:

#21

Due Date: APRIL 2, 2005

Title: CARDIAC DISEASE TREATMENT AND DEVICE

CERTIFICATE UNDER 37 CFR 1.8:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Petition, Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 February 21, 2005.

By: *Linda M. Beckman*
Name: Linda M. Beckman

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

23552

PATENT TRADEMARK OFFICE

Sir:

We are transmitting herewith the attached:

- ☒ Transmittal Sheet in duplicate containing Certificate of Mailing
- ☒ Other: Request to Withdraw Holding of Abandonment
- ☒ Return postcard

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers or any future reply, if appropriate. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. A duplicate of this sheet is enclosed.

Merchant & Gould P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903
612.332.5300

By: *Timothy R. Conrad*
Name: Timothy R. Conrad
Reg. No.: 30,164
TRC:lmb

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MAR 03 2005

TECHNOLOGY CENTER R3709



09/880,576

PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	ALFERNESS ET AL.	Examiner:	B. SZMAL
Serial No.:	09/880,576	Group Art Unit:	3736
Filed:	JUNE 13, 2001	Docket No.:	11998.5USC2
Title:	CARDIAC DISEASE TREATMENT AND DEVICE		

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 21, 2005.

By: *Linda M. Beckman*
Name: Linda M. Beckman

REQUEST TO WITHDRAW HOLDING OF ABANDONMENT

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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TECHNOLOGY CENTER R3700

Dear Sir:

This communication is in response to the Notice of Abandonment mailed January 6, 2005, citing Applicant's failure to respond to the Office letter mailed April 2, 2004 (copy enclosed). Applicant respectfully submits that the holding of abandonment is in error and withdrawal of the abandonment is requested.

Applicant responded to the Office Action mailed April 2, 2004 by filing via facsimile an Amendment and Response on June 15, 2004. A copy of the Amendment and Response is submitted herewith, along with a copy of an Auto-Reply Facsimile Transmission, confirming receipt of same.

Also enclosed is a copy of a Communication Confirming Telephone Conference filed via facsimile on November 10, 2004, along with an Auto-Reply Facsimile Transmission, confirming receipt of same.

In view of this evidence, Applicant requests withdrawal of the holding of abandonment, and the Amendment and Response is believed to be in order.

It is assumed that the petition fee of \$130.00 is not required in this case. However, if such fee is deemed to be required, it should be charged to the undersigned's Deposit Account No. 13-2725.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: _____

21 February 2015



Timothy R. Conrad
Reg. No. 30,164
TRC:lmb



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,576	01/13/2001	Clifton A. Alferness	11998.SUSC2 ✓	7153

34379 7590 01/06/2005

ACORN CARDIOVASCULAR, INC.
P.O. BOX 2903
MINNEAPOLIS, MN 55402

EXAMINER

SZMAL, BRIAN SCOTT

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 01/06/2005

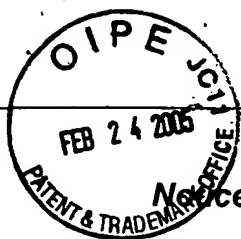
TRC

Revival Lemo: April 02, 2005

Final Revival: Oct. 02, 2005
D✓

Please find below and/or attached an Office communication concerning this application or proceeding.

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TECHNOLOGY CENTER

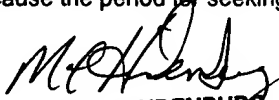


Notice of Abandonment	Application No.	Applicant(s)	
	09/880,576	ALFERNESS ET AL.	
	Examiner	Art Unit	
	Brian Szmaj	3736	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address–

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 02 April 2004.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:


MAX F. HINDENBURG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

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TECHNOLOGY CENTER 3700

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.



S/N 09/880,576

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Alferness et al.	Examiner:	B. Szmaj
Serial No.:	09/880,756	Group Art Unit:	3736
Filed:	June 13, 2001	Docket No.:	11998.5USC2
Title:	CARDIAC DISEASE TREATMENT AND DEVICE		
Customer No.:	34379	Confirmation No.:	7153

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. 703-872.9306 on June 15, 2004.

By: Victoria Hanson

Name: Victoria Hanson

Amendment and Response

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to an Office Action mailed April 2, 2004, please consider the following remarks.

Amendments to the Claims are reflected in the listing of claims that begins on page 2 of this paper.

Remarks begin on page 4 of this paper

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Amendments to the Claims:

This listing of claims will replace all prior versions and listings of claims in the application.

Listing of Claims:

1-17. Cancelled

18. (Currently amended) A method for treating cardiac disease of a heart, the method comprising:

accessing a diseased heart;

selecting a device sized to be placed on the a diseased heart, including selecting a device of electrical permeability sufficient to apply trans-chest defibrillation of the heart; ~~and~~

placing the device on the heart, the device comprising biocompatible material configured to engage a surface of the heart to constrain circumferential expansion of the heart; and

passing an electrical current to and from the heart.

19-31. Cancelled

32. (Previously presented) The method of claim 18 further comprising securing the device on the heart.

33. (Previously presented) The method of claim 32, wherein the device is secured on the heart with sutures.

34. (Previously presented) The method of claim 18 further comprising adjusting said device to snugly conform to the external geometry of the heart.

35. (Previously presented) The method of claim 18, wherein said biomedical material is a substantially non-elastic material.
36. (New) The method of claim 18, wherein said step of passing an electrical current to and from the heart is accomplished using electrical elements.
37. (New) The method of claim 36, wherein said electrical elements are pacer leads.

REMARKS

Claims 18 and 32-37 remain pending in this application after entry of this amendment. Claim 18 was amended herein. Support for the amendment to claim 18 can be found at least at page 13, lines 17-19. Claims 36-37 were added herein. Support for newly added claim 36 can be found at least at page 11, lines 21-22. Support for newly added claim 37 can be found at least at page 11, lines 21-22.

Claim 18 is objected to because of informalities. Applicant respectfully traverses this rejection.

Claims 18 and 32-35 are rejected under 35 U.S.C. § 102(b) as being anticipated by Alferness (U.S. Patent No. 5,702,343). Applicant respectfully traverses this rejection.

Objection

Claim 18 is objected to because of the informality in line 4, "a diseased heart", which should read "the diseased heart" because of the disclosure of "a diseased heart" in line 3 of the claim. Claim 18 has been amended in accordance with the suggestion of the Examiner. Applicant therefore respectfully requests that this objection be withdrawn.

Rejection Under 35 U.S.C. § 102

Claims 18 and 32-35 are rejected under 35 U.S.C. § 102(b) as being anticipated by Alferness (U.S. Patent No. 5,702,343). Applicant notes as a preliminary matter that Alferness '343 is not prior art under 35 U.S.C. § 102(b). The effective filing date of this application is July 13, 1998, the filing date of the earliest application in the line of continuations (i.e. the filing date of application serial number 09/114,510, now U.S. Patent No. 6,123,662). In order for Alferness '343 to be prior art under 35 U.S.C. § 102(b), it should have issued before July 13, 1997, one year prior to the effective filing date of the application. Alferness '343 was issued on December 30, 1997, and is therefore not prior art under 35 U.S.C. § 102(b), but is instead prior art under 35 U.S.C. § 102(e).

Based on the above, the Applicant will address the rejection as if it were a rejection of claims 18 and 32-35 under 35 U.S.C. § 102(e). Claim 18 has been amended to add the step of "passing an electrical current to and from the heart ". Applicant notes

that the Examiner states that "even though Alferness '343 fails to explicitly disclose the ability to apply trans-chest defibrillation when the jacket is in place...". Therefore, based on the Examiner's own assertion, Alferness '343 does not anticipate amended claim 18.

Applicant also notes that Alferness '343 is not a proper basis for an obviousness rejection because Alferness '343 is not properly considered prior art under 35 U.S.C. § 103. According to 35 U.S.C. § 103(c) and MPEP § 706.02(k), subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person".

Applicant respectfully asserts that the subject matter of Alferness ('343) was, at the time of the invention of the subject matter of the instant application, owned by the same entity or subject to an assignment thereof to the same entity. Therefore, Alferness ('343) is not prior art under 35 U.S.C. § 103.

Based on the amendment to claim 18, and the comments offered above, Applicant respectfully requests that the rejection of claims 18 and 32-35 be withdrawn.

Although not raised with respect to the pending claims, Applicant notes that the disclosure of Alferness '343 was apparently considered an enabling reference for the element "selecting a device of electrical permeability sufficient to apply trans-chest defibrillation of the heart". If the amount of disclosure provided by Alferness '343 regarding electrical permeability and trans-chest defibrillation enables it as prior art for that element, then amended claim 18 cannot be said to be non-enabled for "passing an electrical current to and from the heart" because it provides much more disclosure regarding that claimed element.

Conclusion

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date:

June 15, 2004

Anna M. Nelson
Anna M. Nelson
Reg. No. 48,935

Auto-Reply Facsimile Transmission



TO:

Fax Sender at 6123329081

Fax Information

Date Received:

Total Pages:

6/15/2004 3:07:59 PM [Eastern Daylight Time]

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06-15-04 02:03 PM	FED-Express & Co. 13	6123329081	1-102	P.081/107	P-017
Merchant & Gould An Intellectual Property Law Firm			3200 Elm Center 10 South Eighth Street Minneapolis, Minnesota 55403-2215 USA tel 612.332.3300 fax 612.332.9081 www.merchant- gould.com		
Fax Transmission June 15, 2004			A Professional Corporation		
TO: Commissioner for Patents Attn: <u>Examiner B. Serna</u> P.O. Box 1450 Alexandria, VA 22313-1450		FROM: Anna M. Nelson			
OUR REF: 11998.5USC2		TELEPHONE: 612.332.4701			
Total pages, including cover letter: 7					
PTO FAX NUMBER 1-703-872-9306					
If you do NOT receive all of the pages, please telephone us at 612.371.5394, or fax us at 612.332.9081.					
Title of Document Transmitted: <u>Amendment and Response</u>					
Applicant: <u>Aliboness et al.</u>					
Serial No.: <u>09/880,716</u>					
Filed: <u>June 13, 2001</u>					
Group Art Unit: <u>3716</u>					
Our Ref. No.: <u>11998.000513C2</u>					
Continuation No. <u>7153</u>					
Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers, if appropriate.					
By: <u>Anna M. Nelson</u>			Name: Anna M. Nelson		
Reg. No.: <u>48,955</u>			Reg. No.: 48,955		
I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date shown below.					
<u>Victoria Johnson</u> Signature			<u>June 15, 2004</u> Date		
02833.001					
PAGE 17 * RCV'D AT 6/15/2004 3:07:59 PM [Eastern Daylight Time] * SRC:USPTO-6123329081 * DNR:100 (MMS) 612-40					



S/N 09/880,576

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Alferness et al.	Examiner:	B. Szmal
Serial No.:	09/880,756	Group Art Unit:	3736
Filed:	June 13, 2001	Docket No.:	11998.5USC2
Title:	CARDIAC DISEASE TREATMENT AND DEVICE		

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. 703.872.9306 on November 10, 2004.

By: Linda M. Beckman
Name: Linda M. Beckman

COMMUNICATION CONFIRMING TELEPHONE CONFERENCE

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The undersigned confirms two telephone calls with Examiner Szmal on November 9, 2004 regarding whether Applicants had responded to the most recent Office Action. At the Examiner's request, Applicants are enclosing a June 15, 2004 Amendment and Response to the Office Action of April 2, 2004 which was sent by facsimile. Also enclosed is the Auto-Reply Facsimile Transmission indicating receipt by the Patent Office.

If the Examiner has any further questions regarding the subject matter, he is requested to contact the undersigned by telephone.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: 11/10/04



Timothy R. Conrad
Timothy R. Conrad
Reg. No. 30,164
TRC:lmb

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11/10/2004 10:46 FAX 6123329081		MERCHANT & GOULD		001/011	
Merchant & Gould An Intellectual Property Law Firm					
3200 IDS Center 60 South Eighth Street Minneapolis, Minnesota 55402-2215 USA tel 612.332.5300 fax 612.332.9081 www.merchant-gould.com					
A Professional Corporation					
Fax Transmission November 10, 2004					
TO: Commissioner for Patents Attn: <u>Examiner Smeal</u> P.O. Box 1450 Alexandria, VA 22313-1450			FROM: Timothy R. Conrad OUR REF: 11998.5USC2 TELEPHONE: 612.336.4625		
Total pages, including cover letter: 11 PTO FAX NUMBER 1-703.872.9306					
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Title of Document Transmitted:			<u>Communication Confirming Telephone Conference</u>		
Applicant: <u>Alfness et al.</u> Serial No.: <u>09/880,576</u> Filed: <u>June 13, 2001</u> Group Art Unit: <u>3736</u> Our Ref. No.: <u>11998.5USC2</u> Confirmation No.: <u>7153</u>					
Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers, if appropriate.					
By: <u>[Signature]</u> Name: <u>Timothy R. Conrad</u> Reg. No.: <u>30,164</u>					
I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date shown below.					
<u>[Signature]</u> Signature			<u>11/10/04</u> Date		
0104031.DOT PAGE 011 * RCVD AT 11/10/2004 11:47:58 AM [Eastern Standard Time] * BY: USPTO-EF-XRF-10 * CNIS: 6720308 * CSID: 6123329081 * DURATION (min-ss): 02-56					